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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/514,417	11/15/2004	Stephane Denis Thirouin	P70213US0	2426

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EXAMINER

MCDONALD, SHANTESE L

ART UNIT PAPER NUMBER

3723

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/514,417

Applicant(s)

THIROUIN, STEPHANE DENIS

Examiner

Shantese L. McDonald

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-10,12-15 and 18-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-10,12-15 and 18-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10,12-15,18-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Craig in view of Herzog.

Craig teaches a device, "adapted to" be used with a female recess hand tool, the device comprising an element having three dimensions, one of the three dimensions being substantially smaller than the other two of the three dimensions and being located in a plane perpendicular to an axis of clamping to a mobile element, the element marking or identifying the female recess tool by an inscription corresponding to the dimensions of the female recess tool, (col. 1, lines 8-15), and the inscription being visible inside the female recess tool, the element being constituted by a multi-layer material being constituted by a layer of one of plastic and metallic material, the element being semi-rigid and made of plastic or metallic materials, (col. 3, lines 26-30), the element including a shape complementary to the shape of the female recess tool, (col.3, lines 34-38). Craig also teaches a device that is "adapted to" be secured in the tool by forces of friction, the forces of friction being generated by rubbings between an inner wall of the female recess and a lateral surface of the element. Craig teaches all the limitations of the claims except for the layer of ink having a protective material, the

element being a pellet of concave shape, the pellet having a thickness included between 0.1 and 1.5mm, and the information being inscribed on two faces of the pellet. Herzog teaches a concave pellet for identifying objects comprising a plastic layer, an ink layer and a protective layer, (col. 4, lines 46-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the element of Craig with a protective layer, as taught by Herzog, in order to protect and enhance the durability of the element. It would have been further obvious to have provide the labeling system of Craig with a concave pellet, as taught by Herzog, in order to enhance the variability, and to accommodate a tool with a complementary surface, and since Craig teaches, "the substrate may take on any desired shaped such as a circle, for example", (col. 3, lines 37-38). It would have been further obvious to have made the pellet with a thickness of between 0.1 and 1.5 mm, since it has been held that where the general conditions of a claims are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. It would also been obvious to inscribed the information on two faces of the pellet, as a mere matter of design choice.

Response to Arguments

Applicant's arguments with respect to claims 1-10,12-15 and18-29 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner notes that after further review of the claims, the claims are merely claiming a device that is "adapted to" be used with a female tool. The Applicant is not claiming the device in combination with the female recess tool, and therefore the claims

merely read on a device that is "adapted to" be inserted in female recess, or basically a label that could be inserted in a female recess of a tool. The Craig reference in view of Herzog teaches the above listed limitations of the claims as presently claimed without the combination of the female recess tool.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shantese L. McDonald whose telephone number is (571) 272-4486. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.L.M.

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October 30, 2006

A handwritten signature in black ink, appearing to read "Joseph J. Hail, III". The signature is stylized with a large, sweeping initial "J" and a prominent "H".

Joseph J. Hail, III
Supervisory Patent Examiner
Technology Center 3700